



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------|------------------|
| 09/929,242 | 08/13/2001 | Stephen F. Gass | SDT 306 | 8807 |
| 27630 | 7590 | 08/10/2005 | EXAMINER | |
| SD3, LLC 22409 S.W. NEWLAND ROAD WILSONVILLE, OR 97070 | | | ASHLEY, BOYER DOLINGER | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3724 | |

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,242

Applicant(s)

GASS ET AL.

Examiner

Boyer D. Ashley

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,10,19-24 and 30-41 is/are pending in the application.
- 4a) Of the above claim(s) 30-41 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-24 is/are allowed.
- 6) ☒ Claim(s) 1,5 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/24/05; 6/4/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3724

DETAILED ACTION

1. This office action is in response to applicant's amendment filed 5/27/05, wherein claims 2-4, 6-9, 11-18, and 25-29 were canceled; claims 10,19, 21,22,23, and 24 were amended; and claims 30-41 were added. It should be noted that the below double patenting rejections are based upon known and available co-pending applications and although it is believed that all appropriate rejections have been made, applicant's help in determining all appropriate double patenting rejections with all of applicant's applications is requested do to the large number of similar applications.

Election/Restrictions

2. Newly submitted claims 30-41 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

3. For example, the Inventions of claims 1, 5, 10, and 19-24 and claims 30-41 are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. For example, invention of claims 1, 5, 10, 19-24 have separate utility such as they could be used without the trunnion and limiting stop with impact absorbing material of claims 30-41; conversely, the invention of claims 30-41 could be used without the worm gear, spring to push the tool, and band saw blade. See MPEP § 806.05(d).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 30-41 are withdrawn from consideration

Art Unit: 3724

as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

SPECIAL CIRCUMSTANCES OF THIS APPLICATION:

Even if a copending application is listed on this instant application or other copending applications or patents and the material information is technically of record in one or more parent or copending applications, the unusually large number of applicant's cases in varying stages of the examination process might result in one or more parent applications not being readily available for review, or material information of record not being readily apparent. Moreover, applications, which may not have any direct relationship, as continuing applications, to other copending applications by the same assignee may not be readily apparent due to the unusually large number of applicant's cases.

Applicant should point out such material information to the examiner of the instant application if the criteria for materiality applies, and if the examination record provides applicant reason to believe such information has not been considered by the examiner. This should include a listing of all related cases whether previously filed, recently filed, currently being filed, or patented.

If, to the best of applicant's knowledge, applicant has no previous patent or copending application, which would meet the definition of "material," applicant is requested to make a statement of that fact of record.

Any parent application labeled as a CIP or Divisional is assumed to claim a patentably distinct invention from the claims of this application and therefore the issue of double patenting has not been considered and the rights to priority are limited to the common disclosed subject matter unless it is brought to the examiners attention that some claims are not distinct.

37 CFR 1.56. Duty to disclose information material to patentability.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

- (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or
- (2) It refutes, or is inconsistent with, a position the applicant takes in:
 - (i) Opposing an argument of unpatentability relied on by the Office, or
 - (ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to

Art Unit: 3724

evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16, and 18-20 of copending Application No. 10/251,576. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in the claim terminology used but encompass the same subject matter, that is, claims 11-12, 16, and 18-20 of copending application 10/251,576 anticipates the language of claim 1 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/955,418. Although the conflicting claims are not identical, they are

Art Unit: 3724

not patentably distinct from each other because they differ only in the claim terminology used but encompass the same subject matter, that is, claim 1 of copending application 09/955,418 anticipates the language of claim 1 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1, 5, and 10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27, 29, 30, 37, 38, 39, 40 of copending Application No. 09/676,190. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in the claim terminology used but encompass the same subject matter, that is, claims 27, 29, 30, 37, 38, 39, and 40 of copending application 09/676,190 anticipates the language of claims 1, 5, and 10 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claim 10 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,877,410. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in the claim terminology used but encompass the same subject matter, that is, claims 1-20 of U.S. Patent 6,877,410 anticipates the language of claim 10 of the instant application.

9. Claims 1, 5, and 10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of

Art Unit: 3724

copending Application No. 10/794,161. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in the claim terminology used but encompass the same subject matter, that is, claims 1-19 of copending application 10/794,161 anticipates the language of claims 1, 5, and 10 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claim 10 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, and 11 of U.S. Patent No. 6,813,983. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in the claim terminology used but encompass the same subject matter, that is, claims 1, 4, and 11 of U.S. Patent 6,813,983 anticipates the language of claim 10 of the instant application.

Allowable Subject Matter

11. Claims 19-24 appear to be allowable over the prior art of record.

Response to Arguments

12. Applicant's arguments filed 5/27/05 have been fully considered but they are not persuasive.

Applicant's comments regarding the first paragraph of the last office action are correct, in that, the paragraph was intended to read "It should be noted that for the purpose of this office action the below rejections under 35 U.S.C. 101 (Statutory double patenting) and/or nonstatutory double patenting ...". Applicant's attention is further

Art Unit: 3724

directed to MPEP section 804 and more specifically to Chart I-B. The examiner cannot assume that the inventions are commonly owned at time of applicant's invention.

Applicants comments regarding the double patenting rejection using claims 11-12 and 14 of application 10/251,576 are persuasive and henceforth withdrawn; however, the double patenting rejection with claims 16, 18-20 remain.

Applicant contends the double patenting rejection with application 09/955,418 is improper because the instant application claim 1 is drawn to a woodworking machine while the copending application is drawn to a up-cut chop saw. However, the examiner respectfully disagrees because they are both wood working machines. As to claim 10, the double patenting has been withdrawn in light of the current amendments and applicant's comments.

Applicant contends that contends the double patenting rejection with application 09/676,190 is improper because the instant application claims 1 and 5 are limited to machines with a detection system adapted to detect contact between a person and the tool. However, as the applicant has amended the instant application and copending application 09/676,190 changes in the double patenting rejections have been made above. Claims 27, 29, 30 and 37-40 of copending application 09/676,190 require "contact" between a user and a tool.

Applicant contends the double patenting rejection with application 10/051,782 is improper because the instant application claim 10 requires a braking component. However, the examiner respectfully disagrees because copending application 10/051,782 claims a brake system and therefore includes brake "component".

Art Unit: 3724

Applicants comments regarding the double patenting rejection using copending application 10/643,296 are noted. In light of claim amendments and applicant's comments the double patenting rejection using 10/643,296 is henceforth withdrawn.

Applicant contends the double patenting rejection with application 10/794,161 is improper because copending application claims are more specific. However, the maintains the double patenting rejection because they are not patentably distinct. If they were they any file generic and specific claims even though the specific claims read on the generic and that is contrary to intent of the double patenting statutes and rules

13. For the reasons above, the grounds of rejection are deemed proper.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

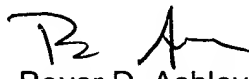
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3724

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 571-272-4502. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Boyer D. Ashley
Primary Examiner
Art Unit 3724

BDA
August 7, 2005